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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,788	12/12/2003	Tommy Rodrigues	FDN-2824 (17017)	3477

7590 05/20/2005

Attn: William J. Davis, Esq.  
GAF MATERIALS CORPORATION  
Legal Dept., Building No. 10  
1361 Alps Road  
Wayne, NJ 07470

EXAMINER
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RUDDOCK, ULA CORINNA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/734,788

Applicant(s)

RODRIGUES ET AL.

Examiner

Ula C. Ruddock

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12-12-03</u> . | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, drawn to a roofing shingle, classified in class 442, subclass 180.
  - II. Claims 15-21, drawn to a process of making a roofing shingle, classified in class 156, subclass 60.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by another method, i.e. by coextruding the substrate and the organic film.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with William Davis on April 19, 2005, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Objections***

6. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 2 requires that "said organic film is formed of an organic film," while the independent claim requires an organic film. The dependent claim fails to further limit the independent claim.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, and 6-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Pinault et al. (US 2002/0160151). Pinault et al. disclose an integrated granule product that includes a film having granules. The product is suitable for roofing products (abstract) and roofing shingles [0021]. The product also contains a cured adhesive and an asphalt-based substrate [0021]. The film materials can be polyethylene terephthalate and polyamide [0022]. The adhesive can be a urethane or acrylic adhesive [0027]. The granules can be conventional granule materials utilized in such application as roofing products [0035]. Suitable substrates include a mat or web wherein the mat is saturated or coated with asphalt. Preferred materials comprise a non-woven matting of fiberglass [0049]. Regarding claims 6 and 11, it should be noted that because the Pinault reference discloses the same materials as Applicant, the thermoplastic film will have a melting point higher than the melting temperatures of the asphalt coating said substrate or the thermosetting film will have a decomposition temperature higher than the melting temperature of the asphalt coating said substrate.

9. Claims 1-4, 6, 7, and 9-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al. (US 2002/0110679). Miller et al. disclose a storm proof asphalt-based roofing material includes a substrate coated with an asphalt coating, a protective coating, a layer of granules, and a web bonded to the lower region of the asphalt coating (abstract). The substrate is a nonwoven web of glass fibers [0036]. An asphalt coating is applied to the nonwoven web of glass fibers [0038]. The web is then coated with granules [0040]. The protective coating is applied as a film [0041] and can function as an adhesive. The adhesive can include any type of thermoplastic, thermoset, or asphalt-based adhesive. Some examples include polyamide, rubbers, polyesters,

polyurethanes, and siloxanes 0052]. The film can also be polyvinyl chloride [0070]. Regarding claims 6 and 11, it should be noted that because the Miller reference discloses the same materials as Applicant, the thermoplastic film will have a melting point higher than the melting temperatures of the asphalt coating said substrate or the thermosetting film will have a decomposition temperature higher than the melting temperature of the asphalt coating said substrate.

10. Claims 1-7 and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Tajima et al. (US 4,636,414). Tajima et al. disclose a laminate bituminous roofing membrane. The membrane includes a fibrous sheet, a first bituminous layer laminated on one surface of the fibrous sheet, the bituminous layer being composed of bitumen or a bituminous mixtures, a synthetic resin sheet or film laminated on the other surface, and a mineral aggregate layer deposited on the surface (abstract). The fibrous sheets can be nonwoven glass fabrics and are impregnated with bitumen or a bituminous mixture (col 3, ln 50-62). The resin sheets include polyvinyl chloride or polyester (col 3, ln 63-68 to col 4, ln 1-3). The bituminous layers can be rubber modified bitumen (col 4, ln 19-29). The laminated bituminous roofing membranes can be applied or bonded to a substrate by using adhesives such as rubber-modified bitumen (col 5, ln 43-57). Regarding claims 6 and 11, it should be noted that because the Tajima reference discloses the same materials as Applicant, the thermoplastic film will have a melting point higher than the melting temperatures of the asphalt coating said substrate or the thermosetting film will have a decomposition temperature higher than the melting temperature of the asphalt coating said substrate.

### ***Conclusion***

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UCR *UCR*

*Ula Ruddock*  
**Ula C. Ruddock**  
Primary Examiner  
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